

Application Serial No. 10/822,882  
Amendment dated July 28, 2006  
Response to Office Action dated May 30, 2005

**REMARKS/ARGUMENTS**

Applicant has received and carefully reviewed the Office Action of the Examiner mailed May 30, 2005. Claims 1-34 remain pending. Reconsideration and reexamination are respectfully requested.

**Premature Finality of Office Action**

Applicant submits that the Office Action was improperly made final and respectfully request the finality of the Office Action be withdrawn. In the response filed March 15, 2006, Applicant did not amend claims 1-20 and 24-34. In the current Final Office Action, a new rejection of these claims was made under 35 U.S.C. § 101. The new ground of rejection was not necessitated by any amendments, and therefore the finality of the current Final Office Action is improper. Withdrawal of the finality of the current Final Office Action, and entry and full consideration of this response is respectfully requested.

**Initialed Copies of IDS's**

Applicant would like to thank the Examiner for providing initialed copies of the Form-1449 that were filed by Applicant on September 28, 2005, February 2, 2006, and March 28, 2006. However, initialed copies of the Form-1449's filed on July 19, 2004 and November 16, 2005 do not appear to be included. As such, *Applicant respectfully requests that the Examiner provide initialed copies of the Form-1449's filed on July 19, 2004 and November 16, 2005.*

**Rejection under 35 U.S.C. § 101**

Claims 1-34 are rejected as not producing a real life, real world, useful, concrete, and tangible result. Applicant respectfully traverses the rejection. The basis for the rejection is not understood. The present claims are directed to methods for testing an HVAC system and involve specific methods steps to be performed. Applicant submits that testing an HVAC system does produce a real life, real world, useful, concrete, and tangible result. The specification states, for

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example, "These methods can allow for efficient checking and, if required, maintenance of a large number of HVAC systems. Further, these methods can provide for remote checking of HVAC systems and allow service contractors to service the HVAC systems that actually need to be maintained." See page 2, lines 5-8. Applicant submits that methods for testing an HVAC system clearly has real world, concrete applications.

The Examiner appears to be asserting that the claimed methods involve only the manipulation of an abstract idea or are merely the starting point for future investigation or research. Applicant does not understand the basis for the rejection. The methods involve specific method steps to be performed in the testing process. The method steps involve tangible, concrete elements, such as performing a test on a component of the HVAC system, transmitting the test result to a remote location, activating components of the HVAC system, etc. It is unclear how such specific method steps are deemed by the Examiner to be manipulation of an abstract idea or nothing more than an idea or concept.

In particular, claim 25 recites a method for determining which of a plurality of HVAC systems will require maintenance. Claims 29 and 30 recite methods for testing an HVAC system prior to a heating season and cooling season, respectively. Applicant respectfully requests that the Examiner explain how such preventative maintenance methods are deemed to lack real life, real world, useful, concrete, tangible results. Applicant submits that all of the claims are directed to methods involving specific method steps to be performed to achieve a specific result and thus meet the requirements of 35 U.S.C. § 101 for a useful process. If this rejection is maintained, Applicant respectfully requests a detailed explanation of the grounds for rejection.

**Rejection under 35 U.S.C. § 102(b)**

Claims 1-34 remain rejected as being anticipated by Hill et al. (EP 1 196 003 A2). Applicant traverses the rejection. In response to Applicant's previous arguments, the Examiner repeats the assertion that the continuous monitoring/testing of the entire system by Hill et al. would encompass monitoring/testing both the dormant and active components of the HVAC

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system. The Examiner has not, however, addressed Applicant's specific arguments regarding the assertion.

Claim 1 recites:

1. (original) A method for testing an HVAC system for a building structure from a remote location outside of the building structure, the HVAC system having a primarily active component and a primarily dormant component, the method comprising the steps of:  
transmitting a test request to the HVAC system from the remote location;  
performing a test on the primarily dormant component of the HVAC system in response to the test request, and producing a test result; and  
transmitting the test result to a location outside of the building structure.

As can be seen, claim 1 recites the steps of transmitting a test request to the HVAC system from the remote location; performing a test on the primarily dormant component of the HVAC system in response to the test request, and producing a test result; and transmitting the test result to a location outside of the building structure.

The Examiner cites to paragraph [0021], lines 58 and 1-3, of Hill et al. as disclosing the transmitting step of claim 1. Paragraph [0021], lines 58 and 1-3, of Hill et al. states "[w]hen diagnostic information should be displayed in response to the question in step 244, a message is sent to the server in step 246, after which the interface subroutine is invoked in step 248." This, however, does not appear to teach, disclose or suggest transmitting a test request to the HVAC system from the remote location, as recited in claim 1. Rather, this portion of Hill appears to relate to displaying requested diagnostic information of an HVAC device on the entry device 10, and as can be seen in Figure 2B of Hill et al., the entry device 10 appears to request the diagnostic information from server - and not the HVAC device.

Hill et al. do appear to allow a user to use the entry device 10 to access diagnostic or status information relating to the HVAC device 14 (see Hill et al., column 3, lines 6-11). However, the diagnostic or status information appears to already be present in the HVAC device 14. That is, it appears that the HVAC device 14 generates the diagnostic or status information on its own, and not in response to any test request transmitted by the server or entry device.

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More specifically, Hill et al. do not appear to teach continuously monitoring/testing the HVAC system, as asserted by the Examiner. Instead, Hill et al. appear to merely request status and/or diagnostic data from the HVAC controller, either on a regular basis or upon request from the entry device. There appears to be no teaching in Hill et al. that the server or entry device actually initiates any “test” of the HVAC system, and more specifically, transmit a test request to the HVAC system, or performs a test on a primarily dormant HVAC component in response to the test request. The Examiner appears to be assuming that Hill et al. would perform the claimed method step, but has not provided any reasoned statements regarding why one of ordinary skill in the art would make such an assumption, or on which facts such an assumption could be made.

Certainly, it cannot readily be argued that Hill et al. teach or suggest transmitting a test request to the HVAC system from a remote location, and performing a test on the primarily dormant component of the HVAC system in response to the test request, as recited in claim 1. If the Examiner disagrees, Applicant respectfully requests that the Examiner specifically point out where in Hill et al. each of and every method step of claim 1 is disclosed.

In addition, the Examiner's assertion that Hill et al.'s teaching of continuous monitoring/testing of the entire HVAC system anticipates the claimed method step of testing a dormant component of the HVAC system does not appear to be based on any actual teaching in Hill et al. The present specification discloses particular method steps and reasoning for performing a test on a primarily dormant component of an HVAC system. The specification discloses, for example at page 2, line 9 through page 3, line 12, that in a system including both a heating and cooling component, the primarily dormant component may be the cooling system in the winter and the heating component in the summer. The specification states that the present invention may be used to remotely test a primarily dormant component of the HVAC system prior to a heating season or a cooling season.

Applicant submits that in the absence of any specific teaching of performing a test on a primarily dormant component of the HVAC system, the generic teaching of Hill et al. to monitor the HVAC system 14 cannot be interpreted as teaching the claimed method step of performing a test on the primarily dormant component of the HVAC system in response to the test request.

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Further, Hill et al. do not appear to provide any motivation, suggestion or guidance for one of ordinary skill in the art to modify their method to include such a specific method step.

The Examiner asserts that Hill et al. teach querying the HVAC device which would include the dormant and active states. As noted above, there is no indication in Hill et al. that querying the HVAC device 14 includes the specific method step of performing a test on the primarily dormant component of the HVAC system, and in particular, performing a test on a primarily dormant component of the HVAC system in response to the test request. In fact, Hill et al. do not even mention a primarily dormant component.

MPEP 2131 states in order to anticipate a claim, " 'The identical invention must be shown in as complete detail as is contained in the ... claim.' Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Applicant submits that Hill et al. do not appear to teach the particular method steps as claimed in as complete detail as is contained in the claims. Applicant submits that Hill et al. do not teach each and every element of independent claim 1, thus Hill et al. cannot be deemed to anticipate claim 1 or the claims dependent thereon.

With respect to claims 2-5, the Examiner asserts that Hill et al. teach the primarily active component or the primarily dormant component is a cooling component or a heating component, referring to reference number 14 in Figure 1. Reference number 14 in Hill et al., however, merely refers to the "HVAC device" in general. Hill et al. do not teach an active component or a dormant component, or testing of either specific component. The Examiner asserts that the monitoring system of Hill et al. is continuously monitoring/testing the system so it would be a reasonable interpretation to assume that the heating/cooling components are being monitored in both active and dormant states. Applicant respectfully disagrees. As stated above, for a reference to be deemed anticipatory, it must teach the identical invention in as complete detail as is contained in the claims. Further, there does not appear to be any basis for the Examiner's assumption that Hill et al. is testing the HVAC components in both an active and dormant state. Absent such a teaching, Hill et al. cannot be seen to anticipate the specific method steps recited in the claims. Applicant submits that making an assumption as to the operation of a system in a

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reference without any specific teaching to support the assertion is an improper basis for an anticipation rejection.

If the Examiner is considering the specific method steps recited in the claims to be inherent in Hill et al., Applicant submits that there is no basis for such an interpretation. MPEP 2112 IV. states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

(Emphasis added). Applicant submits that the claimed method steps, in particular the steps of transmitting a test request to the HVAC system from a remote location or performing a test on the primarily dormant component of the HVAC system in response to the test request are not necessarily present in Hill et al. It appears the Examiner is asserting that the claimed method steps could be performed by the system of Hill et al., which is not a proper basis for rejection.

The Examiner has maintained the rejection of claim 15, but has not addressed Applicant's specific arguments with respect to this rejection. The Examiner is respectfully requested to provide a response to the following arguments.

With respect to claim 15, the Examiner asserts that Hill et al. teach the HVAC system having two or more zones and a test that is performed activates the primarily dormant component in conjunction with each of the two or more zones, pointing to paragraph 7 for support. Applicant has carefully reviewed paragraph 7 of Hill et al. and has found no such teaching. As stated above, Hill et al. do not appear to teach transmitting a test request to the HVAC system from a remote location or performing a test on the primarily dormant component of the HVAC

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system in response to the test request. In addition, Hill et al. do not appear to teach a test that activates a dormant component in conjunction with each of two or more zones, as is recited in claim 15.

The Examiner has maintained the rejection of independent claims 21, 25, 29, 30, and 31, and the claims dependent thereon, but has not addressed Applicant's specific arguments with respect to these claims. The Examiner is respectfully requested to provide a response to the following arguments.

Independent claim 21 recites, in part, the specific method step of:

performing one or more tests on each of the HVAC systems in response to the test request, and producing a test result for each of the HVAC systems, wherein at least one of the one or more tests that is performed activates and tests one or more of the active or dormant component of an HVAC system

(Emphasis added). Independent claim 29 recites a specific method step of activating a heating component even though the HVAC system would not normally call for heat. Independent claim 30 recites a specific method step of activating a cooling component even though the HVAC system would not normally call for cool.

Hill et al. do not appear to teach these and other method steps. Hill et al. do not appear to teach one or more tests that activate a component of the HVAC system that is not normally called for. Instead, and if anything, Hill et al. appear to be merely passive in this regard (i.e. Hill et al. do not appear to transmitting any tests to the HVAC controller, but merely read up any status and/or diagnostic data provided by the HVAC controller). Further, as stated above, Hill et al. do not appear to teach anything with regard to a primarily dormant component of the HVAC system. Applicant submits that the general monitoring/control method of Hill et al. cannot be seen to anticipate the specific method steps of activating a particular component of the HVAC system and then testing that component. In particular, the general monitoring/controlling methods of Hill et al. cannot be seen to anticipate the specific method steps of activating a heating component even though heat is not called for, or activating a cooling component even though cooling is not called for, as is recited in claims 29 and 30, respectively. Hill et al. thus do

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not teach each and every element of independent claims 21, 29, or 30 or the claims dependent thereon.

With respect to claim 25, the Examiner points to paragraph 32, lines 46-50 of Hill et al. as teaching the step of identifying which of the HVAC systems will likely need service by analyzing the test results. This passage of Hill et al., however, states:

Status information on the HVAC devices which is contained in the unit database is either updated on a regular basis or when requested by a message from the entry device.

Applicant submits that Hill et al.'s teaching of updating status information cannot be seen to anticipate the specific method step of analyzing test results and identifying which of a plurality of HVAC systems will likely need service based on those test results, as is recited in independent claim 25. Hill et al. do not appear to teach each and every element of the claim and thus cannot be deemed to anticipate the independent claim or the claims dependent thereon.

The Examiner has maintained the rejection of claims 26-28, but has not addressed Applicant's specific arguments with respect to this rejection. The Examiner is respectfully requested to provide a response to the following arguments.

Regarding claim 26, the Examiner asserts that figure 1 of Hill et al. discloses the step of providing different test requests to at least two of a plurality of HVAC systems, wherein each test request identifies a different test to be performed. Figure 1 merely illustrates two entry devices in communication with a server that is in communication with two HVAC devices. Neither figure 1, nor any other portion of Hill et al. appears to teach the method step recited in claim 26. As noted above, Hill et al. do not appear to transmit any test requests, as asserted by the Examiner.

Regarding claim 27, the Examiner asserts that it is within reasonable interpretation to infer that a service technician would charge for his/her services. Applicant respectfully traverses the rejection. As stated above, making an assumption as to a method step that is not supported by a specific teaching in a reference appears to be an improper basis for an anticipation rejection. Additionally, even if such assumption were correct, the assumption that a technician would

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charge for work does not meet the elements of the claim. Claim 27 recites the step of charging an owner an amount that depends on the particular test that is performed on the HVAC system. Hill et al. do not appear to teach such method step.

The Examiner asserts that Hill et al. teach the method step of scheduling service on at least some of the HVAC systems that have been identified as likely needing service, as is recited in claim 28, citing paragraph 7, lines 30-35 for support. Applicant has carefully reviewed this passage in Hill et al. and has found no such teaching. Hill et al. teach a method in which status information is provided upon request and updated on a server, and in which settings on at least one HVAC device are changed from an entry device. Hill et al. do not appear to teach any steps relating to scheduling service for HVAC systems that have been identified as likely needing service.

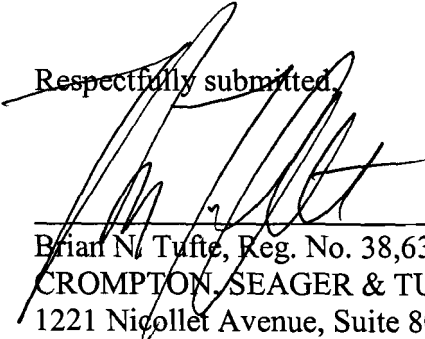
Independent claim 31 recites a method including the steps of receiving one or more maintenance signals at each HVAC system, the maintenance signals activating an HVAC component, performing a self-test on the activated component, generating self-test result signals, and transmitting and receiving the self-test results to a remote unit. As stated above, Hill et al. do not appear to teach a signal that activates an HVAC component. Additionally, Hill et al. do not appear to teach transmitting a maintenance signal that activates a component. Hill et al. thus do not appear to teach each and every element of the independent claim or the claims dependent thereon. Additionally, Hill et al. do not appear to teach the specific elements of dependent claims 32-34. Thus, Hill et al. fail to teach each and every element of the claims and cannot be deemed to anticipate the claims. Reconsideration and withdrawal of the rejection is respectfully requested.

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Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims 1-34 are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

Respectfully submitted,

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Brian N. Tufte, Reg. No. 38,638  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2402  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349